

105TH CONGRESS
2D SESSION

S. 2193

To implement the provisions of the Trademark Law Treaty.

IN THE SENATE OF THE UNITED STATES

JUNE 18, 1998

Mr. HATCH (for himself and Mr. LEAHY) introduced the following bill; which
was read twice and referred to the Committee on the Judiciary

A BILL

To implement the provisions of the Trademark Law Treaty.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Trademark Law Trea-
5 ty Implementation Act”.

6 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

7 For purposes of this Act, the Act entitled “An Act
8 to provide for the registration and protection of trade-
9 marks used in commerce, to carry out the provisions of
10 certain international conventions, and for other purposes”,
11 approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be
12 referred to as the “Trademark Act of 1946”.

1 **SEC. 3. APPLICATION FOR REGISTRATION; VERIFICATION.**

2 (a) APPLICATION FOR USE OF TRADEMARK.—Sec-
3 tion 1(a) of the Trademark Act of 1946 (15 U.S.C.
4 1051(a)) is amended to read as follows:

5 “SECTION 1. (a)(1) The owner of a trademark used
6 in commerce may request registration of its trademark on
7 the principal register hereby established by paying the pre-
8 scribed fee and filing in the Patent and Trademark Office
9 an application and a verified statement, in such form as
10 may be prescribed by the Commissioner, and such number
11 of specimens or facsimiles of the mark as used as may
12 be required by the Commissioner.

13 “(2) The application shall include specification of the
14 applicant’s domicile and citizenship, the date of the appli-
15 cant’s first use of the mark, the date of the applicant’s
16 first use of the mark in commerce, the goods in connection
17 with which the mark is used, and a drawing of the mark.

18 “(3) The statement shall be verified by the applicant
19 and specify that—

20 “(A) the person making the verification believes
21 that he or she, or the juristic person in whose behalf
22 he or she makes the verification, to be the owner of
23 the mark sought to be registered;

24 “(B) to the best of the verifier’s knowledge and
25 belief, the facts recited in the application are accu-
26 rate;

1 “(C) the mark is in use in commerce; and

2 “(D) to the best of the verifier’s knowledge and
 3 belief, no other person has the right to use such
 4 mark in commerce either in the identical form there-
 5 of or in such near resemblance thereto as to be like-
 6 ly, when used on or in connection with the goods of
 7 such other person, to cause confusion, or to cause
 8 mistake, or to deceive, except that, in the case of
 9 every application claiming concurrent use, the appli-
 10 cant shall—

11 “(i) state exceptions to the claim of exclu-
 12 sive use; and

13 “(ii) shall specify, to the extent of the ver-
 14 ifier’s knowledge—

15 “(I) any concurrent use by others;

16 “(II) the goods on or in connection
 17 with which and the areas in which each
 18 concurrent use exists;

19 “(III) the periods of each use; and

20 “(IV) the goods and area for which
 21 the applicant desires registration.

22 “(4) The applicant shall comply with such rules or
 23 regulations as may be prescribed by the Commissioner.

24 The Commissioner shall promulgate rules prescribing the

1 requirements for the application and for obtaining a filing
2 date herein.”.

3 (b) APPLICATION FOR BONA FIDE INTENTION TO
4 USE TRADEMARK.—Subsection (b) of section 1 of the
5 Trademark Act of 1946 (15 U.S.C. 1051(b)) is amended
6 to read as follows:

7 “(b)(1) A person who has a bona fide intention,
8 under circumstances showing the good faith of such per-
9 son, to use a trademark in commerce may request reg-
10 istration of its trademark on the principal register hereby
11 established by paying the prescribed fee and filing in the
12 Patent and Trademark Office an application and a verified
13 statement, in such form as may be prescribed by the Com-
14 missioner.

15 “(2) The application shall include specification of the
16 applicant’s domicile and citizenship, the goods in connec-
17 tion with which the applicant has a bona fide intention
18 to use the mark, and a drawing of the mark.

19 “(3) The statement shall be verified by the applicant
20 and specify—

21 “(A) that the person making the verification be-
22 lieves that he or she, or the juristic person in whose
23 behalf he or she makes the verification, to be enti-
24 tled to use the mark in commerce;

1 “(B) the applicant’s bona fide intention to use
2 the mark in commerce;

3 “(C) that, to the best of the verifier’s knowl-
4 edge and belief, the facts recited in the application
5 are accurate; and

6 “(D) that, to the best of the verifier’s knowl-
7 edge and belief, no other person has the right to use
8 such mark in commerce either in the identical form
9 thereof or in such near resemblance thereto as to be
10 likely, when used on or in connection with the goods
11 of such other person, to cause confusion, or to cause
12 mistake, or to deceive.

13 Except for applications filed pursuant to section 44, no
14 mark shall be registered until the applicant has met the
15 requirements of subsections (c) and (d) of this section.

16 “(4) The applicant shall comply with such rules or
17 regulations as may be prescribed by the Commissioner.
18 The Commissioner shall promulgate rules prescribing the
19 requirements for the application and for obtaining a filing
20 date herein.”.

21 (c) CONSEQUENCE OF DELAYS.—Paragraph (4) of
22 section 1(d) of the Trademark Act of 1946 (15 U.S.C.
23 1051(d)(4)) is amended to read as follows:

24 “(4) The failure to timely file a verified statement
25 of use under paragraph (1) or an extension request under

1 paragraph (2) shall result in abandonment of the applica-
 2 tion, unless it can be shown to the satisfaction of the Com-
 3 missioner that the delay in responding was unintentional,
 4 in which case the time for filing may be extended, but for
 5 a period not to exceed the period specified in paragraphs
 6 (1) and (2) for filing a statement of use.”.

7 **SEC. 4. REVIVAL OF ABANDONED APPLICATION.**

8 Section 12(b) of the Trademark Act of 1946 (15
 9 U.S.C. 1062(b)) is amended in the last sentence by strik-
 10 ing “unavoidable” and by inserting “unintentional”.

11 **SEC. 5. DURATION OF REGISTRATION; CANCELLATION; AF-**
 12 **FIDAVIT OF CONTINUED USE; NOTICE OF**
 13 **COMMISSIONER’S ACTION.**

14 Section 8 of the Trademark Act of 1946 (15 U.S.C.
 15 1058) is amended to read as follows:

16 “DURATION

17 “SEC. 8. (a) Each registration shall remain in force
 18 for 10 years, except that the registration of any mark shall
 19 be canceled by the Commissioner for failure to comply
 20 with the provisions of subsection (b) of this section, upon
 21 the expiration of the following time periods, as applicable:

22 “(1) For registrations issued pursuant to the
 23 provisions of this Act, at the end of 6 years follow-
 24 ing the date of registration.

1 “(2) For registrations published under the pro-
2 visions of section 12(c), at the end of 6 years follow-
3 ing the date of publication under such section.

4 “(3) For all registrations, at the end of each
5 successive 10-year period following the date of reg-
6 istration.

7 “(b) During the 1-year period immediately preceding
8 the end of the applicable time period set forth in sub-
9 section (a), the owner of the registration shall pay the pre-
10 scribed fee and file in the Patent and Trademark Office—

11 “(1) an affidavit setting forth those goods or
12 services recited in the registration on or in connec-
13 tion with which the mark is in use in commerce and
14 such number of specimens or facsimiles showing cur-
15 rent use of the mark as may be required by the
16 Commissioner; or

17 “(2) an affidavit setting forth those goods or
18 services recited in the registration on or in connec-
19 tion with which the mark is not in use in commerce
20 and showing that any such nonuse is due to special
21 circumstances which excuse such nonuse and is not
22 due to any intention to abandon the mark.

23 “(c)(1) The owner of the registration may make the
24 submissions required under this section within a grace pe-
25 riod of 6 months after the end of the applicable time pe-

1 riod set forth in subsection (a). Such submission is re-
2 quired to be accompanied by a surcharge prescribed by
3 the Commissioner.

4 “(2) If any submission filed under this section is defi-
5 cient, the deficiency may be corrected after the statutory
6 time period and within the time prescribed after notifica-
7 tion of the deficiency. Such submission is required to be
8 accompanied by a surcharge prescribed by the Commis-
9 sioner.

10 “(d) Special notice of the requirement for affidavits
11 under this section shall be attached to each certificate of
12 registration and notice of publication under section 12(c).

13 “(e) The Commissioner shall notify any owner who
14 files 1 of the affidavits required by this section of the Com-
15 missioner’s acceptance or refusal thereof and, in the case
16 of a refusal, the reasons therefor.

17 “(f) If the registrant is not domiciled in the United
18 States, the registrant shall designate by a written docu-
19 ment filed in the Patent and Trademark Office the name
20 and address of some person resident in the United States
21 on whom may be served notices or process in proceedings
22 affecting the mark. Such notices or process may be served
23 upon the person so designated by leaving with that person
24 or mailing to that person a copy thereof at the address
25 specified in the last designation so filed. If the person so

1 designated cannot be found at the address given in the
 2 last designation, such notice or process may be served
 3 upon the Commissioner.”.

4 **SEC. 6. RENEWAL OF REGISTRATION.**

5 Section 9 of the Trademark Act of 1946 (15 U.S.C.
 6 1059) is amended to read as follows:

7 “RENEWAL OF REGISTRATION

8 “SEC. 9. (a) Subject to the provisions of section 8,
 9 each registration may be renewed for periods of 10 years
 10 at the end of each successive 10-year period following the
 11 date of registration upon payment of the prescribed fee
 12 and the filing of a written application, in such form as
 13 may be prescribed by the Commissioner. Such application
 14 may be made at any time within 1 year before the end
 15 of each successive 10-year period for which the registra-
 16 tion was issued or renewed, or it may be made within a
 17 grace period of 6 months after the end of each successive
 18 10-year period, upon payment of a fee and surcharge pre-
 19 scribed therefor. If any application filed under this section
 20 is deficient, the deficiency may be corrected within the
 21 time prescribed after notification of the deficiency, upon
 22 payment of a surcharge prescribed therefor.

23 “(b) If the Commissioner refuses to renew the reg-
 24 istration, the Commissioner shall notify the registrant of
 25 the Commissioner’s refusal and the reasons therefor.

1 “(c) If the registrant is not domiciled in the United
2 States, the registrant shall designate by a written docu-
3 ment filed in the Patent and Trademark Office the name
4 and address of some person resident in the United States
5 on whom may be served notices or process in proceedings
6 affecting the mark. Such notices or process may be served
7 upon the person so designated by leaving with that person
8 or mailing to that person a copy thereof at the address
9 specified in the last designation so filed. If the person so
10 designated cannot be found at the address given in the
11 last designation, such notice or process may be served
12 upon the Commissioner.”.

13 **SEC. 7. RECORDING ASSIGNMENT OF MARK.**

14 Section 10 of the Trademark Act of 1946 (15 U.S.C.
15 1060) is amended to read as follows:

16 “ASSIGNMENT

17 “SEC. 10. (a) A registered mark or a mark for which
18 an application to register has been filed shall be assignable
19 with the good will of the business in which the mark is
20 used, or with that part of the good will of the business
21 connected with the use of and symbolized by the mark.
22 Notwithstanding the preceding sentence, no application to
23 register a mark under section 1(b) shall be assignable
24 prior to the filing of an amendment under section 1(c)
25 to bring the application into conformity with section 1(a)
26 or the filing of the verified statement of use under section

1 1(d), except for an assignment to a successor to the busi-
2 ness of the applicant, or portion thereof, to which the
3 mark pertains, if that business is ongoing and existing.
4 In any assignment authorized by this section, it shall not
5 be necessary to include the good will of the business con-
6 nected with the use of and symbolized by any other mark
7 used in the business or by the name or style under which
8 the business is conducted. Assignments shall be by instru-
9 ments in writing duly executed. Acknowledgment shall be
10 prima facie evidence of the execution of an assignment,
11 and when the prescribed information reporting the assign-
12 ment is recorded in the Patent and Trademark Office, the
13 record shall be prima facie evidence of execution. An as-
14 signment shall be void against any subsequent purchaser
15 for valuable consideration without notice, unless the pre-
16 scribed information reporting the assignment is recorded
17 in the Patent and Trademark Office within 3 months after
18 the date of the subsequent purchase or prior to the subse-
19 quent purchase. The Patent and Trademark Office shall
20 maintain a record of information on assignments, in such
21 form as may be prescribed by the Commissioner.

22 “(b) An assignee not domiciled in the United States
23 shall designate by a written document filed in the Patent
24 and Trademark Office the name and address of some per-
25 son resident in the United States on whom may be served

1 notices or process in proceedings affecting the mark. Such
 2 notices or process may be served upon the person so des-
 3 ignated by leaving with that person or mailing to that per-
 4 son a copy thereof at the address specified in the last des-
 5 ignation so filed. If the person so designated cannot be
 6 found at the address given in the last designation, such
 7 notice or process may be served upon the Commissioner.”.

8 **SEC. 8. INTERNATIONAL CONVENTIONS; COPY OF FOREIGN**
 9 **REGISTRATION.**

10 Section 44 of the Trademark Act of 1946 (15 U.S.C.
 11 1126) is amended—

12 (1) in subsection (d)—

13 (A) by striking “23, or 44(e) of this Act”
 14 and inserting “or 23 of this Act or under sub-
 15 section (e) of this section”; and

16 (B) in paragraphs (3) and (4) by striking
 17 “this subsection (d)” and inserting “this sub-
 18 section”; and

19 (2) in subsection (e), by striking the second
 20 sentence and inserting the following: “Such appli-
 21 cant shall submit, within such time period as may be
 22 prescribed by the Commissioner, a certification or a
 23 certified copy of the registration in the country of
 24 origin of the applicant.”.

1 **SEC. 9. TRANSITION PROVISIONS.**

2 (a) REGISTRATIONS IN 20-YEAR TERM.—The provi-
3 sions of section 8 of the Trademark Act of 1946, as
4 amended by section 5 of this Act, shall apply to a registra-
5 tion for trademark issued or renewed for a 20-year term,
6 if the expiration date of the registration is on or after the
7 effective date of this Act.

8 (b) APPLICATIONS FOR REGISTRATION.—This Act
9 and the amendments made by this Act shall apply to any
10 application for registration of a trademark pending on, or
11 filed on or after, the effective date of this Act.

12 (c) AFFIDAVITS.—The provisions of section 8 of the
13 Trademark Act of 1946, as amended by section 5 of this
14 Act, shall apply to the filing of an affidavit if the sixth
15 or tenth anniversary of the registration, or the sixth anni-
16 versary of publication of the registration under section
17 12(c) of the Trademark Act of 1946, for which the affida-
18 vit is filed is on or after the effective date of this Act.

19 (d) RENEWAL APPLICATIONS.—The amendment
20 made by section 6 shall apply to the filing of an applica-
21 tion for renewal of a registration if the expiration date
22 of the registration for which the renewal application is
23 filed is on or after the effective date of this Act.

24 **SEC. 10. EFFECTIVE DATE.**

25 This Act and the amendments made by this Act shall
26 take effect—

- 1 (1) on the date that is 1 year after the date of
2 the enactment of this Act, or
3 (2) upon the entry into force of the Trademark
4 Law Treaty with respect to the United States,
5 whichever occurs first.

